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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/702,625	08/23/96	KLUTH	H1215/1556PC

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EXAMINER

COONEY, J
ART UNIT PAPER NUMBER

1207

DATE MAILED: 09/16/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 6-27-97
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.
- A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 15-68 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 15-68 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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Applicant's arguments filed June 27, 1997 have been fully considered but they are not persuasive.

Rejection under 35 USC 112 is withdrawn, as is the 35 USC 102 component of rejection under 35 USC 102/103 rejection.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-68 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Markusch et al.

Markusch et al. discloses methods for formulating prepolymers for use in the synthesis of polyurethanes which are combined with conventional additives for urethane synthesis and wherein the prepolymers are prepared having reduced contents of free monomeric diisocyanate pre-reactant (see the entire document). Although blowing agents are not particularly recited by the disclosure of Markusch et al., its teaching recognizes the use of other additives. Blowing agents are well known additives which are known to be useful for their expansion initiating effects. Accordingly, it would have been obvious for one having ordinary skill in the art to have utilized blowing agents in the preparations of Markusch et al., which are well known conventional additives in the urethane arts, for the purpose of enabling and imparting expandability in the preparations realized in order to arrive at the products and articles of applicants' claims in the

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absence of a showing of new or unexpected results. Markusch et al. further differs in that it is not particularly concerned with storing its reactants in pressurized vessels. However, storing polyurethane forming reactants in pressurized vessels is well known in the art for storage purposes, and it would have been obvious for one having ordinary skill in the art to have stored the materials of Markusch et al. in pressurized vessels in order to arrive at the systems of applicants' claims.

Applicants' arguments have been considered but the rejection under 35 USC 103 is maintained for the reasons set forth above. Further, Markusch et al.'s disclosure is not limited to the low isocyanate contents pointed to by applicants'. A limited teaching of one, two, or three examples of a references does not derogate from what it teaches as a whole which in the instant case is NCO content values which are inclusive of those claimed by applicants.

Applicants' arguments further assert that the invention of their claims enables the safe disposal of isocyanate based reactant carriers in non-hazardous waste disposal areas. However, Markusch et al. addresses the core of the disposal problem with which applicants are concerned by recognizing and setting forth a means for making prepolymers having reduced residual NCO monomer starting material. Acknowledging that containers having left-over residual reactants with reduced isocyanate monomer contents don't need to be disposed of as toxic waste does not rise to the level of being unexpected when the toxicity problem has already been resolved by the teachings of the prior art.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is (703)308-2433. The examiner can normally be reached on Monday - Friday from 9AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on (703) 308-2462. The fax phone number for this Group is (703) 308-4734.

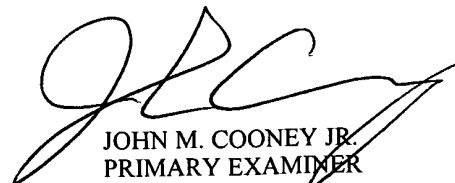
Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [james.seidleck@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

JMC


9/10/97


JOHN M. COONEY JR.
PRIMARY EXAMINER
GROUP 1200